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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,213	06/02/2005	Guy Patrick Hindle	GB920020006US1	4682
50170	7590	01/29/2010	EXAMINER	
IBM CORP. (WIP)			AL HASHEMI, SANA A	
c/o WALDER INTELLECTUAL PROPERTY LAW, P.C.			ART UNIT	
17330 PRESTON ROAD			PAPER NUMBER	
SUITE 100B			2156	
DALLAS, TX 75252			MAIL DATE	
			DELIVERY MODE	
			01/29/2010	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**MAILED**

**JAN 29 2010**

Technology Center 2100

In re Application of: )  
HINDLE et al. )  
Application No. 10/537,213 )  
Attorney Docket No. GB92002006US1 )  
Filed: June 2, 2005 )  
For: SYNCHRONIZING DATA IN A )  
DISTRIBUTED DATA PROCESSING )  
SYSTEM )  
)

**DECISION ON PETITION TO  
WITHDRAW FINALITY OF  
OFFICE ACTION UNDER 37 CFR  
§ 1.181 AND WITHDRAW  
RESTRICTION REQUIREMENT  
UNDER 37 CFR §1.144**

This is a decision on the petition filed August 14, 2009 under 37 C.F.R. §1.181 and 37 C.F.R. §1.144 to withdraw finality of Office Action and to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

### **RELEVANT PROSECUTION HISTORY**

20 November 2008 A non-final Office action was mailed rejecting claims 1-5 and 23.

20 February 2009 An amendment was filed canceling claim 23 and adding new claims 24-31. Claims 1-5 and 24-31 were pending.

15 May 2009 A Final Office action was mailed including (1) maintain rejections of claims 1-5 and (2) withdrawal of claims 24-31 from consideration as non-elected due to the claims 24-31 being directed to an invention that is independent or distinct from the invention originally claimed.

11 August 2009 A response after Final was filed.

14 August 2009 The instant petition was filed seeking (1) to withdraw the improper restriction requirement; and (2) to withdraw the Final Office Action mailed May 15, 2009.

## REGULATIONS AND PRACTICE

### 37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

### 37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

### 37 C.F.R. § 1.145 states:

If, after an Office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

### 37 C.F.R. § 1.181(c) states:

When a petition is taken from an action or requirement of an examiner in the ex- parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

### MPEP § 806.05(d) states in part:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, **are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.** To support a restriction requirement where applicant separately claims plural

subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary... [Emphasis added.]

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse.

**DECISION**

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed a request for reconsideration prior to the petition of 14 August 2009 in accordance with 37 C.F.R. § 1.143. Although the restriction was never made final in accordance with MPEP § 821.01, the initial restriction requirement was maintained in two telephone communications on 21 July 2009 and 04 August 2009. To expedite prosecution of this application, the telephone communications of 21 July 2009 and 04 August 2009 (not of record) are being treated as a Final restriction requirement.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

A review of the restriction based on original presentation mailed 15 May 2009, it revolves that the examiner held the invention of newly added claims 24-31 and the invention of claims 1-5 as being disclosed as usable together but they do not have to be together and she provided no further explanations, reasons and/or examples to support her conclusion. MPEP § 806 does not have such a language as referred by the examiner. Thus, the examiner's statement has been interpreted as subcombinations usable together in a single combination.


As stated in MPEP § 806.05(d), two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, **are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants**. A review of the new added claims 24-31 and the pending claims 1-5 indicates that these two set of claims are substantially overlap in scope and are obvious variants. Therefore, the restriction based on original presentation is **improper**.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**. Further, since the restriction based on original presentation is improper, the Final Office Action mailed 15 May 2009 is herewith **WITHDRAWN** and **VACATED**.

The application is being forwarded to the examiner for consideration on the merits of claims 24-31.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (571) 272-3613.

A handwritten signature in black ink, appearing to read "Wendy R. Garber", written over a horizontal line.

Wendy R. Garber, Director  
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Computer Architecture and Software